

APPLICANT(S): B. Carmeli, et al.
SERIAL NO.: 10/699,081
FILED: October 31, 2003
Page 6

REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Applicant objects to the "late" issuance of the rejection under 35 USC 101. This rejection could have and should have been presented in the first office action. No material changes were made to these claims with respect to patentable subject matter and the basis on which Examiner is now issuing a rejection is equally applicable (or inapplicable) to the amended claim and the original claim text.

"Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. ... Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art." M.P.E.P. § 707.07(g).

Moreover, issuance of a final rejection is premature and the final rejection, therefore, should be withdrawn. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement ..." The basis for a rejection under 35 U.S.C. 101 was not created due to any amendment to the claims. If the subject matter of the claims are not patentable, then the issue was equally extent with the original claim language as with the amended text. The patentability and nature of the subject matter were not changed by the amendment.

APPLICANT(S): B. Carmeli, et al.
SERIAL NO.: 10/699,081
FILED: October 31, 2003
Page 7

Status of Claims

Claims 13 - 19 and 21 are pending herein and rejected.

The Examiner also rejected Claim 20, but that claim was previously canceled without prejudice or disclaimer.

Claims 13 and 18 have been amended in order to further define what the Applicants consider to be the invention. Applicants respectfully assert that no new matter has been added.

No other amendments have been made.

CLAIM REJECTIONS

35 U.S.C. § 101 Rejection

In the Office Action, the Examiner rejected claims 13 – 21 under 35 U.S.C. § 101 as not falling within one of the four statutory categories of invention. Applicants respectfully traverse this rejection in view of the remarks that follow.

As stated in M.P.E.P. 2106.02 “if the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. ... In practical terms, claims define nonstatutory processes if they: - consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or - simply manipulate abstract ideas...”

All of the herein claims are statutory because they are not mathematical operations and they do not simply manipulate abstract ideas. Instead there is a specific multi step process that transforms and manipulates data so that short messages may be transmitted with minimal delay.

The subject matter of the claims is positively tied to a transmitting network device that accomplishes the method steps. Moreover, the subject matter of the claims have a

APPLICANT(S): B. Carmeli, et al.
SERIAL NO.: 10/699,081
FILED: October 31, 2003
Page 8

practical application – packets are transmitted (claim 13) or passed to a network device for transmission (claim 18).

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this response to Deposit Account 09-0468.

Respectfully submitted,

By: /Suzanne Erez/
Suzanne Erez
Reg. No. 46,688
Phone No. 1-888-260-5928

Date: 2 March 2009
IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598